

O/0971/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003986100

IN THE NAME OF SHENZHEN SIBIONICS CO., LTD

FOR THE FOLLOWING TRADE MARK:

SiBio

IN CLASSES 5, 9, 10, 29, 30 AND 42

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT

IN DEFENCE OF AN OPPOSITION

UNDER NO. 446761

BY SIRIO PHARMA CO., LTD.

BACKGROUND

1. On 30 November 2023, Shenzhen Sionics Co., Ltd ('the Applicant') applied for the trade mark no. 3986100 in the UK. The mark has a priority date of 18 August 2023, based on registrations in China. Registration is sought for goods and services in classes 5, 9, 10, 29, 30 and 42. The full specification is annexed to this decision.
2. On 9 April 2024, Sirio Pharma Co., Ltd ('the Opponent') opposed the application by way of filing a notice of opposition and statement of case ('Form TM7'). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act') and is directed against the goods and services applied for in classes 5, 29, 30 and 42, only.
3. The Opponent relies on the following two earlier registrations:

i) WO0000001540417

The logo for SIRIO features the word "SIRIO" in a bold, black, sans-serif font. Above the letters "I" and "R" is a thick, black, curved horizontal line that arches over the space between them.

Date of protection of the international registration in the UK: 15 July 2021

Designation date: 3 April 2020

International registration date: 3 April 2020

Office of origin: China

Registered for the following:

Class 32:

Non-alcoholic condensed smoked plum juice; whey beverages; beer; non-alcoholic beverages; orgeat; smoothies; plant-based beverages; pastilles for effervescing beverages; soft drinks; sports drinks.

Class 40:

Chemical reagents processing; custom assembling of materials for others; sorting of waste and recyclable material [transformation]; material treatment information; vulcanization [material treatment]; water treating; grinding; air purification; medicinal material processing; food and drink preservation.

ii) UK00003282207

**SIRIO**

Filing date: 12 January 2018

Date of entry in register: 4 May 2018

Registered for the following:

Class 5:

Herbal medicine; Medicines for human purposes; Veterinary preparations; Medicines for veterinary purposes; Slimming pills; Dietary supplements for animals; Health food supplements made principally of minerals; Chewing gum for medical purposes; Candy for medical purposes; Dietetic substances adapted for medical use; Dietetic foods adapted for medical purposes; Dietetic beverages adapted for medical purposes; Crude drugs; Food for babies; Liquid vitamin supplements; Vitamin tablets; Biochemical preparations for medical use; Mineral food supplements; Vitamin preparations; Capsules for medicines; Ointments for pharmaceutical purposes; Dietary fiber; Candy, medicated; Chemical preparations for pharmaceutical purposes; Nutritional supplements; Blood plasma; Injectable pharmaceuticals; Cod liver oil.

Class 42:

Pharmaceutical research services; Cosmetic research; Industrial design; Technical research; Research and development of new products for others; Material testing; Biological research; Scientific laboratory services; Maintenance of computer software; Quality control.

4. On 19 April 2024, the Registry served the Form TM7 on the Applicant accompanied by a letter in the following terms:

'Please find enclosed a copy of the notice of opposition - Form TM7 - filed against your application.

If you wish to continue with your application, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is

filed: <https://www.gov.uk/government/publications/trade-mark-forms-andfees/trade-mark-forms-and-fees>

Rule 18(1) and 18(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8) within **two months** from the date of this letter. Alternatively, if both parties wish to negotiate to resolve the dispute, they may request a "cooling off period" by filing a Form TM9c, which will extend the 2 month period in which to file a Form TM8 by up to a further seven months. Form TM9c is also available on the IPO website (above). Please note both parties must agree to enter into cooling off.

IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 19 June 2024.

Rule 18(2) of the Trade Marks Rules 2008 states that "*where an applicant fails to file a Form TM8 within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, unless the registrar otherwise directs, be treated as abandoned.*" **It is important to understand that if the deadline date is missed, then in almost all circumstances, the application will be treated as abandoned.**'

[Original emphasis]

5. On 19 April 2024, the Registry wrote to the Opponent to inform it that, given its failure to indicate at question 6 of Form TM7 whether or not it had notified the Applicant of the impending opposition proceedings, the Registrar would presume that the proceedings had been instituted without notice.
6. No Form TM8 was filed by the Applicant on or before 19 June 2024.
7. On 25 June 2024, the Applicant filed a Form TM8.
8. On 26 June 2024, the Applicant emailed the Registry with written submissions, including reasons for the late filing of the Form TM8, in the body of the email. Additionally, a Form TM33 was filed to notify the Registry that Abion UK Limited had been appointed as the Applicant's legal representative.
9. On 17 July 2024, the Registry wrote to the Applicant to request that the comments within their email of 26 June 2024 be refiled in the form of a Witness Statement, on or before 31 July 2024.
10. On 25 July 2024, the Applicant filed a Witness Statement in the name of Jeremy Giacopazzi, dated 22 July 2024, reproduced here:

'1. I am a Senior Partner and Country Head for Inlex MEA, a firm of intellectual property lawyers with offices in numerous jurisdictions including at the above address in the United Kingdom. I have oversight of the UK office and am familiar with the internal procedures and processes which are in place to deal with correspondence received from the UKIPO. I have been with the firm of Inlex MEA since its inception in 2023 and have access to all records and files relevant to the matters referred to herein. I am fully conversant in the English language.

2. On or around the 20th of April 2024 the letter from the UKIPO advising my firm of the filing of opposition against the above application by Sirio Pharma Co., Ltd was received at my firm's UK office address. As is my firm's normal practice, the letter was then forwarded to my firm's back-office function in

Mauritius to be scanned and logged onto my firm's internal record management system. At this point, my internal docketing department should have also received a copy of the letter so that the deadline set was entered into our diary system together with a suitable advanced review date. For some reason, this deadline was not entered and instead the letter and TM7 were simply forwarded directly to the attorney who at that time was responsible for the client. Noting our internal procedures, the attorney in question would have assumed that the deadline had been properly docketed. As advised previously, the member of staff responsible for the docketing process is no longer in the employ of my company.

3. The consequence of this error was compounded by the fact that there was subsequently a change of attorneys with responsibility for this particular client, in that I took over responsibility for their matters having never actually had sight of the letter from the UKIPO advising my firm of the opposition having been filed. The previous attorney is also no longer in the employ of Inlex. Given that I had never seen the letter from the UKIPO and was relying upon a forward review of the firms diary to flag up any imminent deadlines (and noting that the deadlines for this matter had never been docketed), it was inevitable that that the deadline would be missed, in particular noting that I had no sense of its imminent arrival, given that I had not been dealing with this particular file previously. Personnel changes had in effect resulted in the normal level of oversight being lost.

4. The subsistence of the opposition finally came to my attention as a result of review which I was conducting of the applicant's files. As soon became aware of the missed deadline, I took steps to try to rectify same and secure the acceptance of a counterstatement into the proceedings.'

11. On 27 August 2024, the Registry wrote to the Applicant in the following terms:

'I acknowledge receipt of your Late TM8 filed on 26 June 2024 and witness statement of 25 July 2024.

The Registry has considered the reasons provided for the Form TM8 being filed outside of the prescribed period. It is noted that a docketing error took place by the applicant's previous representative however, it is the obligation of the applicant to ensure that their TM8 deadline is met, therefore the consequence of missing this deadline rests with them.

It is therefore the Registry's preliminary view that, as the notice of defence and counterstatement would be filed outside of the statutory deadline, it cannot be permitted into the proceedings.

If you disagree with the preliminary view to refuse the late defence, you should request a hearing within 14 days from the date of this letter; that is on or before **10 September 2024**.

If no hearing is requested the preliminary view will become confirmed.'

12. On 29 August 2024, the Applicant confirmed that it wished to have a hearing, which was duly arranged for Friday 13 September 2024.

THE HEARING

13. A hearing took place before me, by telephone conference, on Friday 13 September 2024. Only the Applicant attended, represented by Mr Steven Jennings, of Abion UK Limited. Mr Jennings filed a skeleton argument in advance of the hearing. The Opponent, represented by Handsome I.P. Ltd, filed written submissions in lieu.

14. Mr Jennings' submissions, essentially, cover two main arguments:

i) The Applicant's former legal representative's ordinarily robust procedural system for managing deadlines had failed. The system comprised a structure according to which the central 'controller' of the docketing system, based in Mauritius, had ultimate control of the diary and, therefore, sent out the necessary deadline reminders and papers etc to the London office of the Applicant's representative.

Mr Jennings submitted that the unfortunate coincidental departure of both the paralegal and attorney in charge of the Applicant's case resulted in the Applicant's matter 'bypassing' the central docketing system and, as a consequence, the deadline of 19 June 2024 being missed. It was submitted that the departure of the paralegal meant that the deadline was not entered on to the relevant system; the deadline, instead, being recorded on the physical file to be passed to the attorney. To compound matters, the relevant attorney departed before they had looked at the paper file. Mr Jennings explained that the upshot of this sequence of events was that the deadline for filing the Form TM8 was not acted upon until a member of staff attended to the pile of paper files and discovered that the deadline had been missed.

ii) Mr Jennings highlighted that the Opponent had, on 27 March 2024, applied to register another mark, UK00004031690, identical to the earlier mark relied upon in the opposition proceedings to which the instant matter relates, albeit for a specification said to be closer to that for which registration is sought by the Applicant. Mr Jennings argued that the consequence of the Registrar declining to exercise its discretion in the Applicant's favour regarding the late-filed Form TM8, would be particularly injurious to the Applicant because it made the usual option open to an Applicant in such circumstances (i.e. re-filing the application deemed undefended) more challenging. He argued that the Opponent will have 'armed' itself with a stronger case by being able to rely on its UK00004031690 mark, which is closer to the Applicant's mark than the mark currently relied upon in the instant opposition proceedings, and, further, not yet subject to the proof of use provisions under the Act.

15. The Opponent has submitted that the reasons provided by the Applicant do not amount to 'exceptional circumstances' or 'compelling reasons' and that there is, therefore, no justification for the Registrar to exercise its discretion in the Applicant's favour.

16. I will address the parties' particular submissions in so far as they relate to the relevant factors that I must consider when making my decision, below at [21] – [28].

DECISION

17. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of the Trade Marks Rules 2008 ('the Rules'). The relevant parts read as follows:

"18. – (1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a Form TM8 or counter-statement within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, unless the registrar otherwise directs, be treated as abandoned.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period shall begin on the notification date and end two months after that date."

18. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in Rule 18, which sets out the period within which the defence must be filed, is non-extendable other than in the circumstances identified in Rule 77(5), which states:

"A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if –

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and

(b) it appears to the registrar that the irregularity should be rectified."

19. There has been no suggestion of any irregularity on the part of the Tribunal. Consequently, the only basis upon which the Applicant may be allowed to defend the opposition proceedings is if I exercise in their favour the discretion afforded to me by the use of the words 'unless the registrar otherwise directs' in Rule 18(2). I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the Applicant's favour.

20. In *Music Choice Ltd's Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance in reaching a conclusion as to whether or not the discretion should be exercised in favour of a party in default. That is the approach that I will adopt.

The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed;

21. The explanation provided by the Applicant for the late filing of the Form TM8 is, in essence, a failure of the administrative procedure that the Applicant's legal representative uses to manage deadlines, which was precipitated by the departure of both a paralegal and an attorney within a short time.

22. As noted above, the prescribed deadline for filing the Form TM8 was 19 June 2024. The Form TM8 was filed on 25 June 2024. The deadline was therefore missed by 6 days.

The nature of the Opponent's allegations in its Statement of Grounds;

23. The claim against the Applicant is a partial opposition based upon section 5(2)(b) of the Act and is directed against the Applicant's goods in classes 5, 29, 30 and 42. The Opponent seeks to rely upon two earlier rights. The 'proof of use' provisions are engaged in respect of one of those earlier rights.¹ Whilst it is not for the present hearing to determine the merits of the case, for the purpose of the

¹ Section 6A of the Act.

criteria under consideration, it is sufficient to note that there is an arguable case to be determined.

The consequences of treating the Applicant as defending or not defending the opposition;

24. If the Applicant is allowed to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits. The Opponent may be required to provide evidence of use of its earlier registration UK00003282207.

25. If, however, the Applicant is not allowed to defend the opposition, the application will be deemed abandoned in respect of the opposed goods and services and the Applicant will lose both its filing date of 30 November 2023, and its priority date of 18 August 2023. It will remain open to the Applicant to re-file its application in respect of the opposed goods/services, which may, in turn, be opposed again by the Opponent (or any other party).²

26. Mr Jennings has argued that, if the Applicant is not allowed to defend the instant opposition, then, if it were to re-file its application, the re-filed application would likely be defeated by the Opponent once again filing an opposition, albeit relying on its UK00004031690 registration. Mr Jennings submits that this particular registration is a stronger comparator than the Opponent's other earlier mark UK00003282207 by virtue of the parties' respective goods/services being more closely aligned, and the fact that the Opponent would be free of any obligation to provide evidence of use of the mark.

Any prejudice caused to the Opponent by the delay

27. The Opponent has submitted that it has been prejudiced in terms of the time delay caused by the late filing of the Form TM8, the time taken to prepare its written

² If a party re-files its application more than 6 months after the priority date of the previous filing, then it can no longer rely on that priority date.

submissions in lieu of the instant hearing, and the associated increase in legal costs.

Any other relevant considerations such as the existence of related proceedings between the parties

28. I was not made aware of any other relevant considerations.

Conclusions

29. I have considered both parties' submissions and all of the case papers available to me. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the Applicant's favour, the partial opposition will succeed in full, and the Applicant will lose its filing and priority dates. I further recognise that it may be that the Applicant may simply re-file its application and that this may, once again, be opposed by the Opponent, (or indeed any other party) resulting in opposition proceedings arising at some point in the future. I bear in mind Mr Jennings' argument that, should the Applicant re-file its application, the Opponent may seek to rely upon its registration UK00004031690 in an opposition which may, or may not, defeat that re-filed application.

30. However, I remind myself that the loss of priority and possibility of further proceedings on much the same basis are often the consequence of a failure to comply with the non-extendable deadline to file a Form TM8. I also note that, at the time of the publication of the Opponent's filing of its application for the now-registered mark UK00004031690 (14 June 2024), it would have been open to the Applicant to file an opposition against the Opponent's filing relying upon its opposed mark UK00003986100. The Applicant's mark qualified as an earlier mark by virtue of its filing date of 30 November 2023, which predated the filing date of the Opponent's mark, 27 March 2024. When I asked Mr Jennings why the Applicant did not seek to oppose the Opponent's application, he submitted that it was clear that both parties appear to have coexisted well in their own domestic markets without any problems and that the Applicant deemed the phonetic differences between the marks to be sufficient to avoid conflict between them.

31. Whilst I appreciate that the Form TM8 was filed a relatively short period of 6 days after the prescribed deadline, it is my view that the reasons provided by the Applicant do not amount to extenuating circumstances or compelling reasons to justify exercising my discretion in the Applicant's favour. Whilst I appreciate that the Applicant's legal representative did have a system in place for the management of deadlines, it is my view that it is reasonable to expect a law firm to have some sort of 'back-up' measures in place to deal with situations where the primary docketing system relied upon fails. Furthermore, whilst I recognise that the departure of both a paralegal and an attorney, within a short space of time, would likely have been challenging for the legal representative, my view is that a law firm would be expected to have some sort of system in place for the handover of files/work from outgoing staff to their deputies/replacements prior to their departure. Taking all of the relevant circumstances into account, my view is that the explanation provided by the Applicant is insufficient to justify exercising my narrow discretion to allow the late-filed form TM8 to proceed to be examined. The Applicant has, in my view, been the author of its own misfortune.

Outcome

32. In the light of the foregoing, it is my view that that it would be inappropriate for me to exercise the discretion available under Rule 18(2) in favour of the Applicant. Subject to any successful appeal, the preliminary view to refuse to admit the late filed TM8 and counterstatement is confirmed and the Application will be deemed undefended.

Costs

33. Given that my decision terminates proceedings, I must consider the matter of costs. Although the Opponent has been successful, I note that it did not notify the Applicant that it would be instituting opposition proceedings against it.³ I note the following from TPN 1/2023:⁴

³ The Opponent's Form TM7 at point [6] has been left blank.

⁴ Tribunal Practice Notice (TPN) 1/2023: Costs in proceedings before the Comptroller

“Costs in undefended actions

7. Unless factors exist which suggest otherwise, costs will not be awarded against parties who do not defend an action which has been brought against them without prior notice.”

34. I therefore make no order as to costs.

Dated this 11th day of October 2024

N. R. MORRIS

For the Registrar

Annexe 1

The full specification of goods and services for the applied-for mark UK00003986100 is:

Class 5:

Reagent paper for veterinary purposes; vitamin preparations; diagnostic preparations for medical purposes; medicinal alcohol; cod liver oil; Antidiabetic preparation; insulin; Probiotic preparations for medical use; Coenzyme Q10 dietary supplements; Test strips for measuring blood glucose levels; Reagents for medical use; Medical diagnostic reagents; Edible fish oil for medical purposes; nutritional supplements; dietetic foods adapted for medical purposes; diabetic bread adapted for medical use; glucose dietary supplements; dietetic substances adapted for medical use; protein dietary supplements; cotton for medical purposes; Adhesive tapes for medical purposes.

Class 9:

Medical mobile applications ;medical software; mobile applications for sharing, reporting, maintaining, managing, monitoring, and analyzing analyte data; mobile applications in the fields of health, wellness, disease management, medical diagnostics, nutrition, fitness, and sports performance; sensors for determination of analyte concentrations; sensors for gathering analyte concentration data; sensors for monitoring analyte concentrations; sensors used to measure and provide information related to analyte concentrations; software for sharing, reporting, maintaining, managing, monitoring, and analyzing analyte data; software in the fields of health, wellness, disease management, medical diagnostics, nutrition, fitness, and sports performance; Sensors for non-medical purposes.

Class 10:

Apparatus for use in medical analysis; diagnostic apparatus for medical purposes; health monitoring devices for medical purposes; health monitoring sensors; medical apparatus for determination of analyte concentrations ;medical apparatus for monitoring analyte concentrations; medical devices for monitoring and providing information related to analyte concentrations; patient monitoring devices

for medical purposes; patient monitoring sensors; sensors for determination of analyte concentrations for medical purposes; sensors for gathering analyte concentration data for medical purposes; sensors for medical purposes; sensors for monitoring analyte concentrations for medical purposes; Medical apparatus and instruments.

Class 29:

Cooked meats; meat; Dried meat floss; fish, not live; seaweed extracts for food; Dried fish; vegetables, tinned; fruits, tinned; meat, tinned; jams; vegetables, dried; eggs; milk products; milk; milk shakes; edible fats; jellies for food, other than confectionery; nuts, prepared; Dried edible fungi; Albumen for culinary purposes; Tofu Products.

Class 30:

Coffee; coffee-based beverages; coffee substitutes; cocoa; tea-based beverages; tea; sugar; sweets; sweet food [confectionery]; fruit jellies [confectionery]; golden syrup; molasses for food; honey; cakes; biscuits; confectionery; pastries; oat-based food; bread; instant rice; wheat flour; cereal preparations; noodles; Instant noodles; cereal-based snack food; rice-based snack food; crispy rice; starch for food; dasheen powder; ice cream; cooking salt; vinegar; relish [condiment]; Yeast; essences for foodstuffs, except etheric essences and essential oils; Aromatic preparations for food; Meat tenderizers, for household purposes; gluten additives for culinary purposes.

Class 42:

Cloud platform services for sharing, reporting, maintaining, managing, monitoring, and analyzing analyte data; cloud platform services in the fields of health, wellness, disease management, medical diagnostics, nutrition, fitness, and sports performance; medical cloud platform services; medical software as a service (SAAS); providing temporary use of online non-downloadable medical software; providing temporary use of online non-downloadable software in the fields of health, wellness, disease management, medical diagnostics, nutrition, fitness, and sports performance; software as a service (SAAS) for sharing, reporting,

maintaining, managing, monitoring, and analyzing analyte data; software as a service (SAAS) in the fields of health, wellness, disease management, medical diagnostics, nutrition, fitness, and sports performance; Providing temporary use of online non-downloadable software for sharing, reporting, maintaining, managing, monitoring, and analyzing analyte data.